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**TRANSMITTAL LETTER**

**APPEAL BRIEF**

Applicant : Patrick J. O'Donnell  
App. No : 09/557,234  
Filed : April 24, 2000  
For : METHOD AND APPARATUS FOR  
DISLODGING INSECTS FROM  
PLANTS  
Examiner : A. Valenti  
Art Unit : 3643

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

August 11, 2006

Glen L. Nuttall, Reg. No. 46,188

**Mail Stop Appeal Brief - Patents**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Transmitted herewith for filing in the above-identified application are the following enclosures:

- (X) Corrected Appeal Brief in 69 pages.
- (X) Return prepaid postcard.

Appeal Brief fee was paid previously upon submission of original Appeal Brief. Thus, no fee payment is believed due. However, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Dated: August 11, 2006

Glen L. Nuttall  
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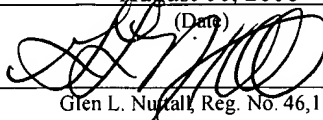
**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant : Patrick J. O'Donnell  
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FROM PLANTS  
Examiner : A. Valenti  
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(Date)  
  
Glen L. Nuttall, Reg. No. 46,188

**CORRECTED APPEAL BRIEF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Corrected Appeal Brief is submitted in response to a Notification of Non-compliant Appeal Brief mailed July 14, 2006. The Appeal Brief has been corrected to fully comply with 37 C.F.R. § 41.37.

Please replace the originally-filed Appeal Brief with this Corrected Appeal Brief.

Should any additional fees be necessary, please charge them to our Deposit Account No. 11-1410.

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**I. REAL PARTY-IN-INTEREST**

The real party-in-interest in this appeal is the Applicant and inventor, Patrick J. O'Donnell.

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**Filed** : **April 24, 2000**

## **II. RELATED APPEALS AND INTERFERENCES**

Applicant is unaware of any related appeals or interferences.

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### **III. STATUS OF THE CLAIMS**

Claims 19-28 and 33-40 are pending in this Application. Claims 1-18 and 29-32 have been cancelled and are thus not at issue in this appeal. Claims 19-28 and 33-40 currently stand rejected; the rejection of these claims is now being appealed. A listing of the claims on appeal is included in the Appendix attached hereto.

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**Filed** : **April 24, 2000**

#### **IV. STATUS OF AMENDMENTS**

No amendments have been filed subsequent to the final rejection mailed September 24, 2004. However, Applicant filed a Request for Reconsideration on March 24, 2005. The Examiner has responded to the Request for Reconsideration in an Advisory Action mailed December 5, 2005. No further amendments or Requests for Reconsideration have been filed.



## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

### **A. Some Gardeners Wish For Chemical-Free Insect Removal And Plant Cleaning**

A pervasive gardening problem is the invasion of insects that feed on garden plants, damaging the health of the plant and often creating unsightly residues. Typically, insects prefer the bottom sides of plant leaves. It is known to spray plants with water to remove the insects. However, spraying tends to be cumbersome, difficult, and time-consuming, and it generally meets with only limited success.<sup>1</sup> The methods recited in independent Claims 19 and 36 solve this problem, and enable users to quickly, easily and very effectively dislodge insects from and clean a plant.

The inventive methods recited in independent Claims 19 and 36 can be described by discussing embodiments reflecting principles of the invention. Such a discussion follows.

### **B. Applicant's Elongate Sprayer Directs A Water Flow Outwardly From An Axis Of The Nozzle Around Substantially The Entire Circumference Of The Nozzle Axis, And Enables A User To Treat Tops And Bottoms Of Plant Leaves**

Figure 1, reproduced below, is a perspective view of an embodiment of the handheld sprayer. In the illustrated embodiment, the sprayer 20 includes a handle 26 and a body 28. A nozzle 30 is at a distal end of the body 28. The sprayer 20 also includes a bend 200. The illustrated embodiment includes two spaced-apart sprays directed outwardly from a longitudinal axis of the nozzle. Other embodiments employ only a single spray.<sup>2</sup>

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<sup>1</sup> See Specification, page 2, line 18 – page 3, line 14.

<sup>2</sup> See *Id.*, at page 6, lines 14-31.

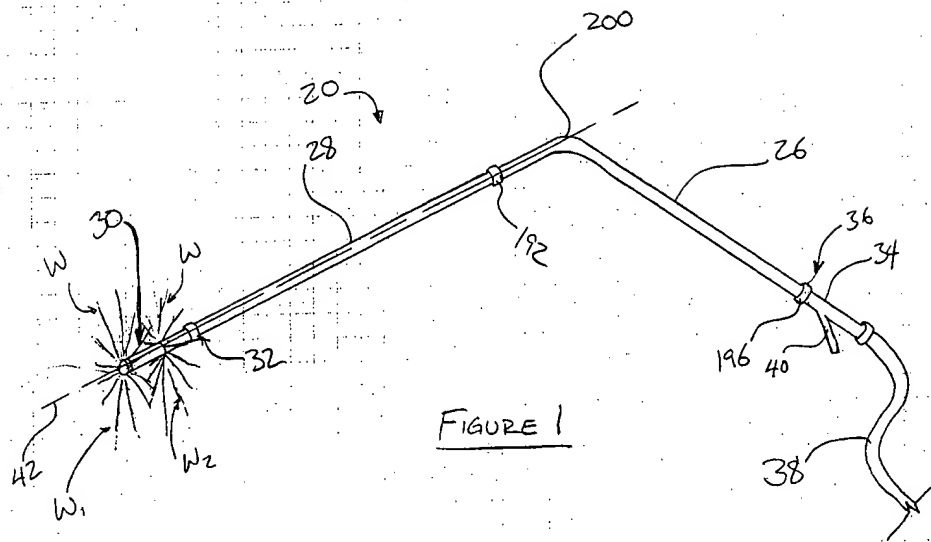
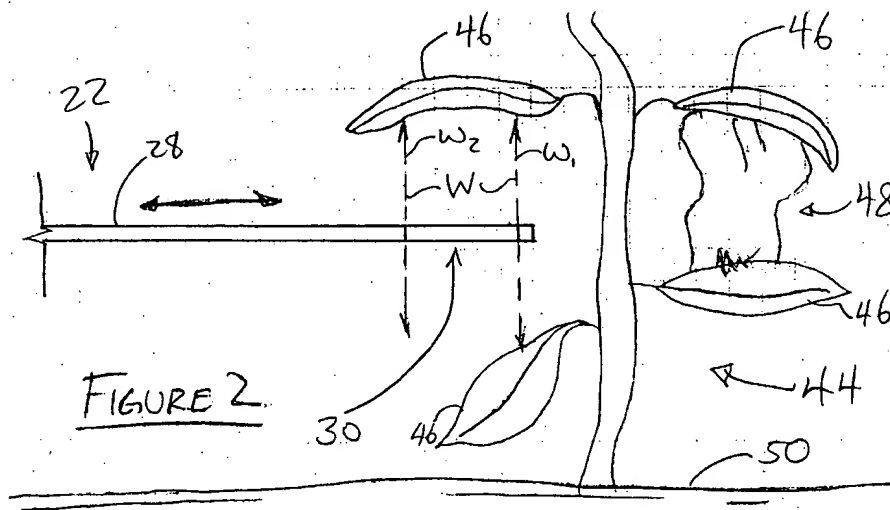


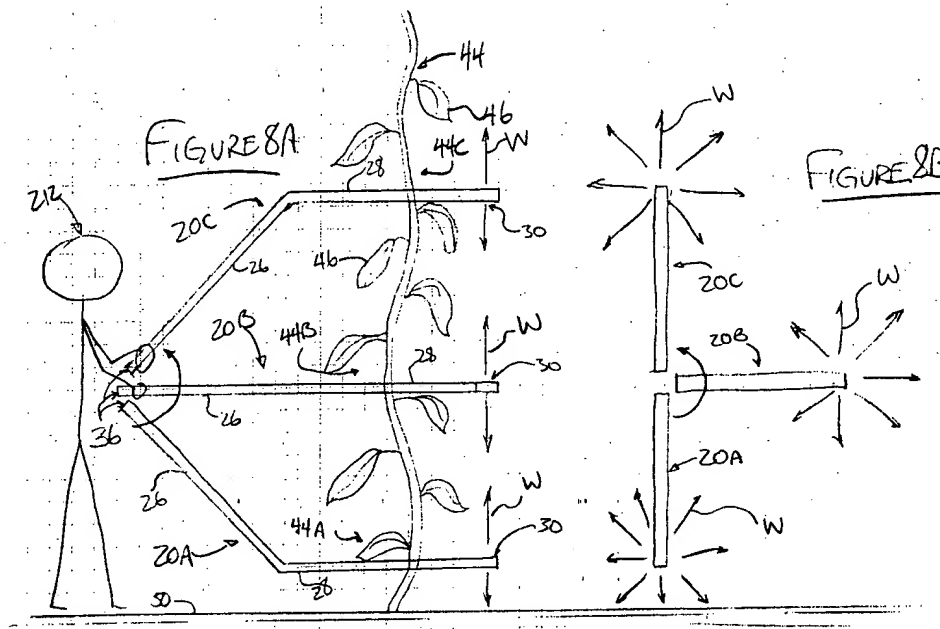
Figure 2, reproduced below, illustrates a method of operating the device for treating a plant. As can be seen, when the device is inserted into a plant with the nozzle axis generally horizontal, water is simultaneously sprayed up and down, simultaneously impacting the bottom sides of some leaves and the top sides of other leaves and supplying a flow of water that not only dislodges insects but also carries such insects off of the plant. The sprayer is then advanced into the plant and retracted to more fully dislodge insects and clean the plant.<sup>3</sup> The method recited in independent Claim 36 covers using such a device according to the method just described.



<sup>3</sup> See *Id.*, at page 7, lines 4-31.

C. Applicant Teaches A Convenient, Quick And Effective Method For Using The Device To Access And Treat All Areas Of The Plant Without Forcing The User To Bend And Contort

Figures 8A and 8B, reproduced below, illustrate an embodiment of Applicant's unique method of using his sprayer. A user standing in one place using the device according to Applicant's method can treat an entire large and tall plant 44 without bending and contorting the user's body.<sup>4</sup>



As shown, during use the axis of the nozzle (30) is kept substantially horizontal. This is beneficial in that, especially in embodiments having a spray that is generally perpendicular to the nozzle axis, the circumferential spray W is directed up and down, and not toward the user. To treat the plant, the user preferably holds the sprayer so that the nozzle axis remains in its horizontal attitude, and repeatedly inserts and removes the nozzle in various areas of the plant.<sup>5</sup> When the user advances and retracts the nozzle, insects are dislodged from leaves and caught up in a water flow that carries them off of the plant. Additionally, insect residues are dislodged and removed by the circumferential water spray.

Figure 8B presents a view of Figure 8A taken from the user's direction. This figure shows how the elevation of the sprayer can easily be changed by rotating the sprayer about the

<sup>4</sup> See *Id.*, at page 14, lines 24-25.

handle, not by the user bending or squatting. For example, when the sprayer is in the low elevation 20A, the user simply rotates the handle about 90° to elevation 20B. Preferably, the spray apparatus is manipulated so that the nozzle remains in a horizontal axis, and the circumferential sprays remain directed generally up and down and not directed towards the user. Thus, the user has effectively lifted the spray nozzle without bending.<sup>6</sup> Both independent Claims 19 and 36 cover the method just described.

This same process can be repeated for substantially all areas of the plant. Although the illustrated embodiment shows a rotation of 90°, it is anticipated that whatever amount of rotation is necessary can be accomplished by the user. However, the unique structure of the device enables the user to rotate the device 90° and more without having to crouch, reach or otherwise change any “aim” of the nozzle. Since the nozzle sprays a circumferential spray, the sprayer behaves the same regardless of how the user has rotated the handle so long as the user maintains the nozzle axis in a generally horizontal attitude.<sup>7</sup>

The methods recited in independent Claims 19 and 36 cover such convenient treatment of a plant by rotating the apparatus at least about 90°. Further, however, these claims recite performance of the method in conjunction with a hand held spraying apparatus having a unique structure that complements the other recited steps. For example, Claim 19 requires a spraying apparatus having a nozzle adapted to direct a generally continuous water flow in a direction outwardly from the axis around substantially the entire circumference of the nozzle axis. Claim 36 requires a spraying apparatus having a nozzle configured to direct a flow of water outwardly generally around a longitudinal axis of the nozzle portion.

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<sup>5</sup> See *Id.*, at page 14, line 14 – page 15, line 3.

<sup>6</sup> See *Id.*

<sup>7</sup> See *Id.*, at page 14, lines 27-30.

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**VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The following grounds of rejection are to be reviewed:

- A. **Whether It Was Proper To Reject Claims 36-38 Under 35 U.S.C. § 103(A) As Unpatentable Over U.S. Patent No. Des425,603 To Guo<sup>8</sup> In View Of The Kimbrew-Walter Roses “Jet-All” Brochure<sup>9</sup>.**
- B. **Whether It Was Proper To Reject 19-28, 33-35, 39 And 40 Under 35 U.S.C. § 103(A) As Unpatentable Over U.S. Patent No. 3,737,105 To Arnold<sup>10</sup> In View Of Guo And Jet-All.**

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<sup>8</sup> Hereinafter referred to as “Guo”.

<sup>9</sup> Hereinafter referred to as “Jet-All”.

<sup>10</sup> Hereinafter referred to as “Arnold”.

## VII. ARGUMENT

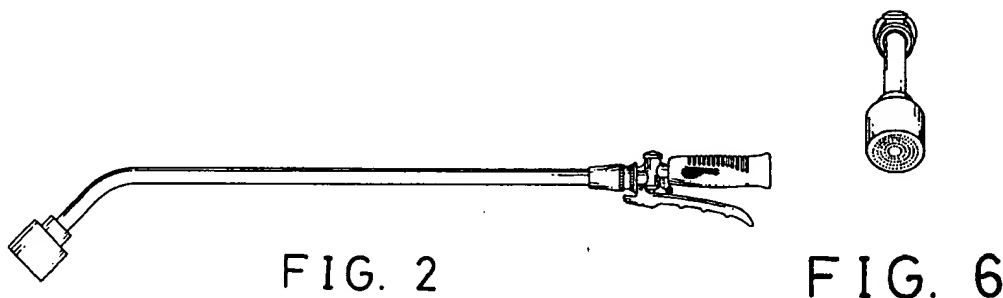
### A. Rejections Under 35 U.S.C. § 103(a)

Under Section 103, the Examiner bears the burden of establishing a *prima facie* case of obviousness. An Examiner can satisfy this burden only by introducing prior art that discloses every element of the claimed invention with some objective teachings in the record that suggest arranging the prior art to produce the Applicant's claimed invention.<sup>11</sup>

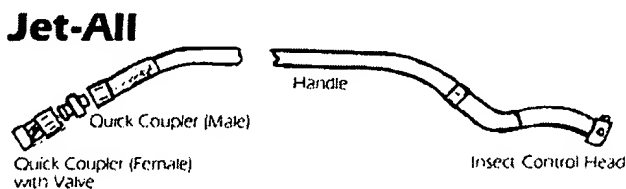
### B. Rejection of Claims 36-38 Under 35 U.S.C. § 103(a)

The Examiner rejected Claims 36-38 under 35 U.S.C. § 103(a) as unpatentable over the Guo sprayer in view of the method of Jet-All.

The Guo reference is a design patent for a sprayer gun. Figures 2 and 6 of Guo, reproduced below, are representative of the Guo disclosure.



The Jet-All sprayer is described in a brochure. Portions of the brochure are reproduced below, including a diagram of the Jet-All and a photograph showing the Jet-All sprayer in use.



<sup>11</sup> See M.P.E.P. § 2143 To establish *prima facie* obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations."; *see also In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Bell*, 991 F.2d 781, 782, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993) ("A *prima facie* case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.").



As illustrated in the brochure, the Jet-All sprayer includes a handle with an “insect control head” connected to the distal end of the handle. The head has three discrete, upwardly-directed jets disposed thereon and is curved “to permit spraying under the leaves of miniature roses as well as the taller varieties without spray back on the user.”<sup>12</sup> As shown in the photographs, the water spray from the jets is directed generally upwardly and away from the user. When the unit is low to the ground, the water spray is nearly horizontal. Presumably, the unit is angled upwardly to spray the “taller varieties” of roses; however, the jet of water will still be directed generally upwardly and away from the user.

1. **The Combination Of Guo And Jet-All Does Not Teach The Structure Recited In The Claims**

In the Office Action discussion rejecting Claims 36-38, the Examiner asserts that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to apply the apparatus taught by Guo in a method of insect removal taught by ‘Jet-all’.”<sup>13</sup> Thus, the Examiner’s rejection is based only on the structure of Guo used according to the method taught by Jet-All, and none of the structure of Jet-All.

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<sup>12</sup> Jet-All brochure.

<sup>13</sup> Office Action mailed 9/24/04, Page 3.

When characterizing the Guo sprayer, the Examiner states that the nozzle is “adapted to direct water flow outwardly around the circumference of the nozzle axis.”<sup>14</sup> However, with reference again to Figures 2 and 6 of Guo, which are reproduced above, the Guo nozzle has water holes formed through its face, which appears to be planar and perpendicular to an axis of the nozzle. Thus, it appears that the Guo nozzle directs several discrete streams of water generally along the nozzle axis.<sup>15</sup> In contrast, Applicant’s Claim 36 requires, *inter alia*, a “nozzle configured to direct a flow of water outwardly generally around a longitudinal axis of the nozzle portion.” Guo does not teach this limitation.

The Examiner also stretches the disclosure of the Jet-All brochure. For example, the Examiner states, “Jet-All teaches . . . the longitudinal axis of the nozzle is generally horizontally disposed at a first elevation and advancing and retracting the nozzle generally horizontally....”<sup>16</sup> With reference again to the above figures reproduced from the Jet-All brochure, the Jet-All brochure shows the device being used such that an axis of the nozzle is at a substantial angle, clearly more than 45°, from horizontal. Perhaps Jet-All is capable of being used at other angles, but it is always shown in an attitude in which the nozzles are oriented to direct spray upwardly from the nozzle and away from the user. In fact, as apparent from the Jet-All sketch, if the Jet-All device is to be truly oriented so that the nozzle axis is generally horizontal, the handle of the device will necessarily be lower than the nozzle when the nozzle sprays upwardly.

Applicant asserts that the Jet-All brochure does not teach what the Examiner says it teaches. Accordingly, the method of Jet-All does not teach at least the limitation “while maintaining the nozzle axis in a generally horizontal attitude, repeatedly advancing and retracting the nozzle into and out of the interior portion of the plant at a plurality of locations in the first region so that water flow is directed onto undersides of interior leaves of the plant and top sides of interior leaves of the plant” of Claim 36.

Since the references do not disclose at least these claim limitations, Applicant requests that the rejection of these claims be reversed.

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<sup>14</sup> *Id.*, Page 2.

<sup>15</sup> Incidentally, the Jet-All device also only emits discrete streams of water.

<sup>16</sup> *Id.*, Page 2.



**2. None Of The Cited References Explicitly Teaches The Claimed Method, And  
The Cited Combination Does Not Teach Or Suggest The Claimed Method**

Notwithstanding the above, the Examiner contends that Guo “contains all of the structural limitations of applicant’s claim language and therefore has the capability of performing the method steps presented by ‘Jet-All’.” The Examiner further states:

The intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.<sup>17</sup>

The Examiner has erroneously stated and applied the patent law. 35 U.S.C. § 101 states “Whoever invents or discovers any new and useful process, machine . . . may obtain a patent therefor . . . .” The patent statute further clarifies that “The term ‘process’ means process, art or method, and *includes a new use of a known process, machine, manufacture, composition of matter, or material.*”<sup>18</sup> Further, the M.P.E.P. clarifies, “New and unobvious uses of old structures and compositions may be patentable.”<sup>19</sup>

The claimed invention is structurally different than the cited art; however, even if it were structurally similar to the prior art, Applicant contends that the claimed invention would still be patentable over the cited art. This is because it uses such structure in a manner never before recognized, taught or suggested.

For example, Claim 36 requires, *inter alia*, “rotating the apparatus about the handle at least about 90° to change the elevation of the nozzle axis from a position in the first region to a position in the second region without substantially changing its generally horizontal attitude.” The Examiner admits that neither Guo nor Jet-All alone explicitly or impliedly teaches this method. In fact, it is plain from the Jet-All brochure that rotation of the sprayer about the handle to change the elevation is never contemplated. Nevertheless, the Examiner contends that the combination of Guo and Jet-All “inherently” teaches this claim limitation.

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<sup>17</sup> *Id.*, Page 3.

<sup>18</sup> 35 U.S.C. § 100(b)(emphasis added).

<sup>19</sup> M.P.E.P. § 2112.02.

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**3. The Examiner Has Incorrectly Applied The Doctrine Of Inherency And Has Not Satisfied Her Burden With Regard To Inherency**

The Examiner specifically states “Guo as modified inherently teaches rotating the apparatus at least about 90° so that the longitudinal axis of the nozzle is moved to a second elevation but remains generally horizontally disposed during rotation and advancing and attracting the nozzle generally horizontally at the second elevation to efficiently and effectively treat all size plants.”<sup>20</sup> The Examiner has not provided factual evidence to satisfy this contention of inherency. Moreover, the Examiner has incorrectly applied the principle of inherency.

**a. Inherency applies only to the teachings of a single prior art reference, but the Examiner has applied inherency to a combination of references.**

The Examiner does not contend that the Jet-All reference inherently teaches the method recited in Claim 36, nor does the Examiner contend that the Guo reference inherently teaches the method. Rather the Examiner contends that a combination of Guo and Jet-All inherently teaches the method. Although Applicant disagrees with the Examiner that the combination inherently teaches the claimed method, Applicant first notes that the Examiner has misapplied the principle of inherency.

The Federal Circuit has established that there is no inherent disclosure when a prior art reference must be modified or reconfigured in a special way to produce a missing limitation.<sup>21</sup> Combining a prior art reference with another reference and then asserting that the combination has inherent properties is substantially the same as modifying or reconfiguring either one of the references in a special way to produce a missing limitation. Accordingly, the Examiner’s assertion that the Guo/Jet-All combination has inherent properties that are not inherent to either of the references taken alone is not legally supported.

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<sup>20</sup> Office Action dated 9/24/04, page 3 (emphasis added).

<sup>21</sup> See *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 1052 (Fed. Cir. 1994) (no inherency found when prior art patent disclosed missing limitation if set to a particular water pressure not explicitly disclosed in the prior art patent); *In re Rijckaert*, 28 U.S.P.Q. 2d 1955, 1956 (Fed. Cir. 1993) (no inherency found when prior art reference disclosed limitation if certain settings were assumed).

b. **The claim limitations are not necessarily present in the cited combination of references, and are thus not “inherent” to the combination**

As just discussed, it is inappropriate for the Examiner to assert inherency of a combination of references. However, in this case, even if the combined disclosures of Guo and Jet-All were considered, they still would not satisfy the requirements for inherency, and the Examiner has not presented any factual evidence to support her contention of inherency.

Inherency “may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances *is not sufficient*.”<sup>22</sup> Further, for a claim limitation to be inherently disclosed by a reference, “it must be necessarily present and a person of ordinary skill in the art would recognize its presence.”<sup>23</sup>

Further, inherency does not even exist when a missing claim element is very likely, though not necessarily, present in a prior art reference. For example in *Glaxo, Inc. v. Novopharm, Ltd.*,<sup>24</sup> an infringer unsuccessfully asserted that a patent was invalid by inherent anticipation because the claimed chemical compound was the undisclosed product of a process described in a prior art reference. An expert witness performed the prior art process 13 times, each time producing the claimed invention. When performed by others on two occasions, however, the process produced a different compound. The court therefore found that the prior art process could yield either the claimed compound or another compound, and hence the claimed compound was not *necessarily present* in the prior art reference.<sup>25</sup> Thus, *there is no inherent disclosure when any possible interpretation of the reference would not include the missing element*.

The M.P.E.P. states the following concerning inherency:

To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it *would be so recognized* by persons of ordinary skill.<sup>26</sup>

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<sup>22</sup> *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (emphasis added).

<sup>23</sup> *Crown Operations Int’l Ltd. v. Solutia Inc.*, 62 USPQ2d 1917, 1923 (Fed. Cir. 2002).

<sup>24</sup> 52 F.3d 1043 (Fed. Cir. 1995).

<sup>25</sup> See *Glaxo*, 52 F.3d at 1047-48.

<sup>26</sup> M.P.E.P. § 2112 (emphasis added).

In light of the above discussion, it is clear that for every contention of “inherency,” the Examiner must establish that the method limitation (1) is *necessarily present* in the Guo/Jet-All combination, and (2) that an ordinary person would *recognize* the claimed *method*. The Examiner has not presented facts to establish these points and thus has not satisfied her burden.

One of ordinary skill in the art would not necessarily recognize or wish to perform the claimed method. Even if Guo and Jet-All were combined, there is no motivation for a user to perform the claimed method steps unless taught to do so by some other reference. In fact, *Applicant’s specification is the only reference teaching the motivation to rotate a specially-constructed spraying device in order to change its elevation. “To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.”*<sup>27</sup>

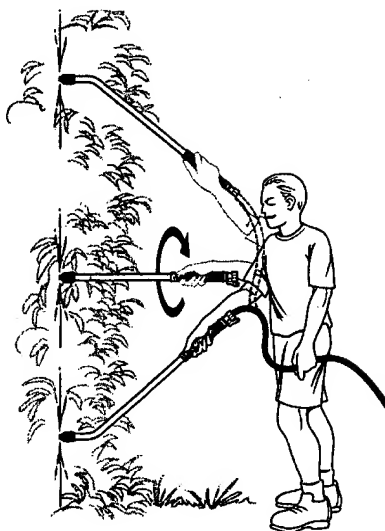
Not only would an ordinary person not recognize Applicant’s claimed method, Applicant has evidence that users find the method “unusual” and can have difficulty performing the method even after having been explicitly taught how to perform it. Applicant’s product was tested by members of the National Home Gardening Club.<sup>28</sup> Applicant’s instructions, a graphical portion of which is reproduced below, were provided to testers along with Applicant’s product. Though many testers immediately grasped the concept, some testers had trouble learning the method.

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<sup>27</sup> *W.L. Gore Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 312-313 (Fed. Cir. 1984) (emphasis added).

<sup>28</sup> Applicant submitted a Declaration on November 8, 2003 including exhibits showing instructional materials that Applicant includes with his device and also including information from a test of Applicant’s product that was performed by the National Home Gardening Club (the “Club”). As part of the Test Program, Applicant submitted his product, which embodies the claims, to several Club members for testing. Applicant paid no money to the Club or to evaluating Club members for participation in the Test Program.

Applicant included explicit graphical instructions with his product; however, some gardeners still had trouble learning how to properly perform the method. The Declaration and exhibits were submitted to the Examiner on November 26, 2003. The 2003 Declaration and exhibits are included in the Appendix.



Narratives from two of the testers are reproduced below.<sup>29</sup>

This is an excellent special-purpose tool that gardeners need and will use. The unusual spray pattern requires a bit of practice (or a raincoat), but it is just what is needed for blasting bugs.<sup>30</sup>

I used the Bug Blaster™ to rid my Lilies of aphids and ants that tend them. Used it several times to keep both under control. First time I used Bug Blaster™ I sprayed myself till I got used to rotate as I raised the wand.<sup>31</sup>

These statements show that people of skill in the art (here, members of the National Home Gardening Club) find Applicant's claimed method counterintuitive, and require practice to get used to the method even after being explicitly taught how to perform it.

The Examiner has not, and indeed cannot, argue that any one of the cited references taken alone inherently discloses the claimed method. For example, the Jet-All reference does not necessarily teach this method, nor is there any evidence that a person of skill in the art would recognize the method from seeing the Jet-All device. The same goes for the Guo/Jet-All combination.

To justify her contentions concerning inherency, the Examiner states that "it is human nature to orient a device in a desired manner to fit the space constraints of the situation." The Examiner goes on to state, "The method steps of the instants [sic] claims are readily apparent

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<sup>29</sup> Other narratives are reproduced later in this brief.

<sup>30</sup> Declaration of Patrick O'Donnell, November 8, 2003, Exhibit B, Member Number: 80722195 (emphasis added).

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during the operation of the device of Arnold and Guo to the application area taught by 'Jet-All'.”<sup>32</sup> These statements appear to be factual assertions, of which the Examiner appears to be taking official notice. In Applicant's Request for Reconsideration filed March 24, 2005, Applicant specifically traversed these “factual findings” and requested that the Examiner provide documentary evidence to support each fact-finding statement. In the Advisory Action mailed December 5, 2005 the Examiner responded to the Request for Reconsideration; however, the Examiner ignored Applicant's traversal, and also did not repeat these factual assertions. Since the Examiner has not provided any documentary evidence to support these statements, these statements cannot be used to maintain the rejection.<sup>33</sup>

As discussed above, an assertion of “inherency” requires specific factual support showing that the method limitation is necessarily present in the prior art and that it would be recognized. The Examiner has presented no factual support, and has not satisfied her burden. However, Applicant has presented factual evidence that people find the method “unusual” and have difficulty learning the method even after having been explicitly taught.

**4. The Examiner Has Not Established A *Prima Facie* Case Of Obviousness.**

An assertion of “obviousness” requires that the references teach all claim limitations. Since the Examiner has not presented facts sufficient to support her inherency arguments, and since the cited references do not teach all of the claim limitations, Applicant respectfully contends that the Examiner's rejection of these claims should be reversed.

**C. Rejection of Claims 19-28, 33-35, 39 And 40 Under 35 U.S.C. § 103(a)**

The Examiner rejected Claims 19-28, 33-35, 39 and 40 under 35 U.S.C. § 103(a) as unpatentable over Arnold in combination with Guo and Jet-All. Applicant contends that not only is there no motivation to combine these references, but the references, even if combined, do not teach or suggest all of the limitations of the claims.

**1. There Is No Motivation To Combine The Cited References**

The Federal Circuit has made clear that “[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching,

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<sup>31</sup> *Id.*, Member Number: 70052476 (emphasis added).

<sup>32</sup> Office Action dated 9/24/04, page 8.

<sup>33</sup> See M.P.E.P. Section 2144.03(c).

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suggestion or incentive supporting the combination.”<sup>34</sup> Further, references that teach away from one another cannot be properly combined to support an obviousness rejection.<sup>35</sup>

Evidence of a suggestion to combine prior art references may flow from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. However, such suggestion must be “clear and particular”.<sup>36</sup> In *In re Dembiczak*,<sup>37</sup> the applicant claimed an orange plastic trash bag with a jack-o-lantern face printed thereon. The application was rejected as obvious in light of the combination of a reference showing a plastic trash bag and a reference describing a method of making a “paper bag pumpkin”. The Federal Circuit reversed the finding of obviousness and held that there was no suggestion to combine the references. Even though the references “described all of the limitations of the pending claims,”<sup>38</sup> no suggestion, teaching, or motivation to combine the references was particularly identified. Thus, the combination was improper.

## **2. There Is No Motivation To Combine Guo With Arnold**

Arnold discloses a spray nozzle for producing a pair of radially-directed sprays. As discussed above, Guo teaches a handheld sprayer with a nozzle having openings that appear to direct several discrete streams of water in a direction generally along the axis of the nozzle. The Examiner states, “It would have been obvious to one of ordinary skill in the art to modify the teachings of Arnold with the teachings of Guo to provide a handle for the ergonomic advantage illustrated by Guo. Since it is old and notoriously well-known to place extensions/handles on nozzles to reach higher elevations or into narrow areas.”<sup>39</sup> This vague and uncertain “motivation” was drummed up by the Examiner, and certainly is not the type of “clear and particular” teaching required by the law. The Guo reference is a design patent, and thus includes no discussion of the use of the device. Arnold, on the other hand, expressly teaches spray that is directed radially. Arnold discloses a use of its nozzle as “a gas washing apparatus,” and also

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<sup>34</sup> *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782,1784 (Fed. Cir. 1995). See, e.g., *In re Stencel*, 828 F.2d 751, 755 (Fed. Cir. 1987).

<sup>35</sup> See *Winner Int'l Royalty Corp. v Ching-rong Wang*, 202 F.3d 1340, 1349-1350 (Fed. Cir. 2000).

<sup>36</sup> *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

<sup>37</sup> *id.*

<sup>38</sup> *Id.* at 1000.

<sup>39</sup> Office Action mailed 9/24/04, Page 4.

indicates that “it is also adapted to various other uses as will be apparent to a person skilled in the art.”<sup>40</sup> However, Arnold contemplates no reason to dispose its nozzle on a spray apparatus having the features of Guo.

Furthermore, the Guo and Arnold references would tend to teach away from one another. Specifically, the Guo nozzle and the Arnold nozzle spray water in perpendicularly different directions. Although Guo does not explicitly describe its purpose, the replacement of Guo’s nozzle with the Arnold nozzle would materially change the operation of the Guo reference because the Guo sprayer would no longer direct water in the direction the nozzle is pointed. This likely would be unsuitable for Guo’s intended purpose.

Since there is no “clear and particular” suggestion in either Guo or Arnold to combine these references, these references are not properly combined.

**3. The Guo/Arnold Combination, Or Even The Arnold Nozzle Taken Alone, Is Not Properly Combined With The Jet-All Method**

As discussed above, the Jet-All brochure depicts the Jet-All sprayer directing a spray away from the user. The Jet-All sprays appear to be directed substantially perpendicular and upward relative to the nozzle axis, and the Jet-All is never shown as being used with the nozzle axis substantially horizontal. Instead, the nozzle axis is shown as tilted forward so that the spray is directed away from the user. This is not surprising, as one of the important aspects of the Jet-All device is that it allows spraying under leaves “without spray back on the user.”<sup>41</sup> If a user were to use a Guo/Arnold combination device, or even a Jet-All device with an Arnold nozzle, in accordance with the method as shown by the Jet-All brochure, the spray from the underside of the nozzle *would be directed towards the user*. The Jet-All brochure expressly teaches that this is undesirable. Thus, these references teach against combination and are not properly combined.

**4. None Of The Cited References Explicitly Teach The Claimed Method, And The Cited Combination Does Not “Necessarily” Teach The Claimed Method**

Claim 19 requires, *inter alia*, “rotating the apparatus at least about 90° so that the longitudinal axis of the nozzle is moved to a second elevation that remains generally horizontally disposed during rotations; and advancing and retracting the nozzle generally horizontally at the

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<sup>40</sup> Arnold, Col. 2, ll. 45-52.

<sup>41</sup> Jet-All Brochure,



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second elevation.” The Examiner states that Arnold as modified by Jet-All “inherently teaches rotating the apparatus at least about 90° so that the longitudinal axis of the nozzle is moved to a second elevation but remains generally horizontally disposed during rotation and advancing and retracting the nozzle generally horizontally at the second elevation to efficiently and effectively treat all size plants.”<sup>42</sup>

The Examiner’s contentions regarding inherency are substantially the same as those in connection with Claims 36 – 38 as discussed above. As such, this assertion of inherency fails for the same reasons set forth above in connection with Claims 36 - 38.

**5. The Examiner Has Not Established A *Prima Facie* Case Of Obviousness.**

Combination of references for an obviousness rejection requires a “clear and particular” teaching in the references suggesting such combination. Further, an assertion of “obviousness” requires that the references teach all claim limitations. Since the Examiner has not identified a motivation to combine the Arnold, Guo and Jet-All references, since the Examiner has not presented facts sufficient to support her inherency arguments, and since the cited references do not teach all of the claim limitations, Applicant respectfully contends that the Examiner’s rejection of these claims should be reversed.

**D. Evidence Of Long-Felt, Unsolved Need Rebutts Any *Prima Facie* Evidence Of Obviousness**

Even if the Examiner has established a *prima facie* case of obviousness, that showing has been rebutted because Applicant’s invention satisfies a long-felt need not solved by others.

Secondary considerations of non-obviousness, such as long-felt but unsolved need, must always be considered in determining whether the claimed design would have been obvious over the prior art.<sup>43</sup> Indeed, such evidence is often the most significant and persuasive evidence on the issue of non-obviousness. As explained by the U.S. Court of Appeals for the Federal Circuit:

[E]vidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not. It is to be considered as part

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<sup>42</sup> Office Action dated 9/24/04, page 5.

<sup>43</sup> M.P.E.P. § 2141.

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of all the evidence, not just when the decision maker remains in doubt after reviewing the art.<sup>44</sup>

According to the M.P.E.P., establishing long-felt need depends on the following factors:

First, the need must have been a persistent one that was recognized by those of ordinary skill in the art. . . .

Second, the long-felt need must not have been satisfied by another before the invention by applicant. . . .

Third, the invention must in fact satisfy the long-felt need.<sup>45</sup>

Applicant's claimed invention satisfies these factors. This is further evidence that Applicant's claimed invention is nonobvious.

During prosecution of the application, Applicant submitted a Declaration in which the Applicant describes a Test Program with the National Home Gardening Club in which Applicant's product embodying the claimed invention (marketed as "The Bug Blaster™") was evaluated by Club Members. Since the results of the Test Program evaluations were positive, The Bug Blaster™ became a recommended product of the National Home Gardening Club, and the Test Program results were published in the Club's periodical, "Gardening How-to".<sup>46</sup>

Pursuant to Exhibit B of the Declaration, several evaluation forms of Club Members from the Test Program are attached. These forms illustrate that there has long been a recognized need for easy removal of insects from plants using water without pesticide; others have tried to satisfy this need, but have failed to come up with an easy and effective way to do it; and The Bug Blaster™ satisfies this need.

The following statements are excerpts from the forms:

Wow! This is great! Now I can blast those bad bugs on the back of the leaves without going through all the contortions trying to reach them with an ordinary stream nozzle. Sure makes it easier on this old back.<sup>47</sup>

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<sup>44</sup> *Simmons Fastener Corp. v. Illinois Tool Works, Inc.*, 739 F.2d 1573, 1575, 222 USPQ 744, 745 (Fed. Cir. 1984).

<sup>45</sup> M.P.E.P. §716.04 (emphasis added).

<sup>46</sup> The Declaration and Exhibits, which were submitted to the Patent Office in 2003, are included in the Appendix.

<sup>47</sup> Declaration of Patrick O'Donnell, November 8, 2003, Exhibit B, Member Number: 70057991 (emphasis added).

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The Blaster is easy to use all instructions advise spray bottom of the leaves. This is so easy with the Bug Blaster and so effective. I have 21 rose bushes, using Bug Blaster it only took a few moments per bush so easy.<sup>48</sup>

The Bug Blaster is the best! I can blast away the garden pests without harming the plants and without using pesticides, very effective. I would recommend it to all my fellow club members.<sup>49</sup>

The Bug Blaster is another great tool for my Garden and Orchard. We live in a very dusty place and since the water spray goes under and over the plants and small trees, I have a healthier and cleaner Garden. Thank you for the Bug Blaster.<sup>50</sup>

It Really works. I had such trouble with aphids before using this. Now no pesticide needed.<sup>51</sup>

Would definitely recommend. Used on my crepe myrtle trees with aphid problem. Didn't need to use any chemicals and it worked.<sup>52</sup>

I have a 100% organic garden which prospers, but it always seems the aphids will zero in on one or two areas. The regular hose end sprayer doesn't quite do the trick, but this blaster really sent those aphids flying. (The birds had a feast too!).<sup>53</sup>

As soon as I received the Bug Blaster, I put it to work. I had been fighting an infiltration of aphids on my cucumber plants. I used the Bug Blaster on the cucumber plants a few times and my aphid problem is gone. The Bug Blaster is very easy to use and doesn't damage the foliage and no chemicals.<sup>54</sup>

Bug Blaster works far better than using the garden hose method alone — the water jet design really does a great job in the veggie garden and the rose garden where aphids attacked this year's cucumbers and half of my prize roses — I was very happy to see Bug Blaster get whiteflies out of the grape arbor!!<sup>55</sup>

My area (Southern Calif.) has a heavy infestation of white flies; anybody who has to deal with this curse, knows how difficult it is to get rid of them. I have now been using my

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48 *Id.*, Member Number: 80827711.

49 *Id.*, Member Number: 70015237.

50 *Id.*, Member Number: 70043504 (emphasis added).

51 *Id.*, Member Number: 80748304 (emphasis in original).

52 *Id.*, Member Number: 81141698 (emphasis in original).

53 *Id.*, Member Number: 80037362 (emphasis added).

54 *Id.*, Member Number: 70001955.

55 *Id.*, Member Number: 70007469 (emphasis added).

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“Bug Blaster” on my 8 ft. tall, heavily infested hybiscus, for fifty consecutive days and . . . almost neary a pesky white fly to be found!! Thank you, Bug Blaster!<sup>56</sup>

This is an excellent alternative to chemical means of getting rid of bugs, and cleans well to. I’ve hesitated to using chemicals so have put up with the bugs. Glad now to have an effective method of being rid of them.<sup>57</sup>

I’ve had a bad whitefly problem this summer and tried safer soap, horticultural oil, and this product. This was by far the funnest and cleanest and least toxic, and worked as well as the other products.<sup>58</sup>

Applicant contends that it is clear from these statements that a need for a reliable way to remove insects from plants without relying on pesticides was well recognized before Applicant’s invention. Further, attempts to solve this need have been made, including spraying plants with a hose or ordinary nozzle, but these attempts have been unsatisfactory, being too difficult, time-consuming, and ineffective. Importantly, hose end sprayers and stream nozzles are substantially the same as the Jet-All sprayer, which directs streams of water only in an upward-and-away-from-the-user direction. Still further, the common theme of the evaluators is to praise The Bug Blaster™ because “It works!”

Applicant contends that the above evidence clearly satisfies the requirements to show that the claimed invention satisfies a long-felt, unsolved need. Specifically, the Test Program evaluations establish that 1) there has long been a recognized need for removing insects from plants without using pesticides; 2) others have tried to address this need, but without success; and 3) Applicant’s claimed invention works for its intended purpose, and satisfies the long-felt, unsolved need. Since this is evidence of nonobviousness, Applicant has rebutted any *prima facie* case of obviousness and provides further reasons why the rejection under 35 U.S.C. § 103 should be reversed.

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<sup>56</sup> *Id.*, Member Number: 70004972.

<sup>57</sup> *Id.*, Member Number: 70036220.

<sup>58</sup> *Id.*, Member Number: 70098546.

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### **VIII. CONCLUSION**

Nothing in the prior art, individually or in combination, discloses, teaches, or suggests the invention recited by the claims on appeal. Further, the prior art references are not properly combined. Still further, Applicant's invention satisfies a long-felt, but unsolved need. Accordingly, Applicant respectfully requests that the Examiner's rejections be reversed and that Claims 19-28 and 33-40 be passed to issuance.

Respectfully submitted,

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Dated: 8/11/06

By: 

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## **IX. CLAIMS APPENDIX**

### **Claims Currently On Appeal in Application Serial No. 09/557,234**

19. A method for removing insects from and cleaning a plant having leaves, the method comprising:

providing a hand held spraying apparatus having a handle, an elongate body portion, and a nozzle portion at a distal end of the body portion, the nozzle portion having a longitudinal axis and being adapted to direct a generally continuous water flow in a direction outwardly from the axis around substantially the entire circumference of the nozzle axis, the apparatus configured so that moving the handle correspondingly moves the nozzle portion;

providing a source of water under pressure;

placing the spraying apparatus into communication with the source of water under pressure;

positioning the nozzle adjacent an underside of a plant leaf so that a portion of the water directed by the nozzle impacts the leaf underside and the longitudinal axis of the nozzle is generally horizontally disposed at a first elevation;

advancing and retracting the nozzle generally horizontally so that a flow of water impacts the leaf underside along its length;

rotating the apparatus at least about 90° so that the longitudinal axis of the nozzle is moved to a second elevation but remains generally horizontally disposed during rotation; and

advancing and retracting the nozzle generally horizontally at the second elevation.

20. The method of Claim 19, wherein the elongate body portion is substantially straight.

21. The method of Claim 20, wherein the nozzle is adapted to direct a flow of water in a substantially vertical plane.

22. The method of Claim 21, wherein the substantially vertical plane is substantially perpendicular to the nozzle portion and comprising the step of holding the elongate body in a substantially horizontal attitude.

23. The method of Claim 22, wherein the handle includes a bend point and comprising the step of adjusting the elevation of the body portion by rotating the handle about a proximal end of the handle.

24. The method of Claim 19, additionally comprising advancing and retracting the apparatus into and out of the plant at a plurality of locations so that the flow of water directed by the nozzle simultaneously impacts the top side of a first plant leaf along at least a portion of its length and the underside of a second plant leaf along at least a portion of its length.

25. The method of Claim 19, wherein the nozzle is adapted to create a substantially planar and contiguous wall of water around the circumference of the nozzle.

26. The method of Claim 25, wherein the nozzle is adapted to create two or more substantially planar and contiguous walls of water around the circumference of the nozzle, the walls of water being spaced apart from each other.

27. The method of Claim 25, additionally comprising advancing and retracting the nozzle between leaves of the plant so that the portions of the wall of water simultaneously impact undersides of leaves generally above the nozzle, top sides of leaves generally below the nozzle, and any matter that may be between the leaves of the plant.

28. The method of Claim 27, additionally comprising advancing and retracting the nozzle between leaves of the plant at a plurality of locations.

33. The method of Claim 23, comprising rotating the handle about an axis of rotation generally parallel to the longitudinal axis of the nozzle.

34. The method of Claim 19, wherein water flow is simultaneously directed upwardly and downwardly.

35. The method of Claim 19, wherein the elongate body portion and the nozzle portion are substantially straight and have substantially the same longitudinal axis.

36. A method of removing insects from and cleaning an interior portion of a leafy plant having a first region and a second region that are disposed at different vertical elevations, comprising:

providing a hand held spraying apparatus having a handle, an elongate body having a length of at least about one foot, and a nozzle at a distal end of the elongate body, the nozzle configured to direct a flow of water outwardly generally around a

longitudinal axis of the nozzle portion, the nozzle portion fixedly connected to the handle and being configured to move with the handle;

placing the spraying apparatus into communication with a source of water under pressure;

while maintaining the nozzle axis in a generally horizontal attitude, repeatedly advancing and retracting the nozzle into and out of the interior portion of the plant at a plurality of locations in the first region so that water flow is directed onto undersides of interior leaves of the plant and top sides of interior leaves of the plant;

rotating the apparatus about the handle at least about 90° to change the elevation of the nozzle axis from a position in the first region to a position in the second region without substantially changing its generally horizontal attitude; and

advancing and retracting the nozzle into and out of the interior portion of the plant at a plurality of locations in the second region.

37. The method of Claim 36 additionally comprising holding the elongate body at a generally horizontal attitude while advancing and retracting the nozzle.

38. The method of Claim 37, wherein the elongate body is at least 18 inches long.

39. The method of Claim 23, wherein the handle is bent about 30-60° at the bend point.

40. The method of Claim 19, comprising rotating the apparatus about 90° while keeping the longitudinal axis of the nozzle generally horizontally disposed during rotation, and advancing and retracting the nozzle generally horizontally into and out of the plant a plurality of times while rotating the apparatus



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## **X. EVIDENCE APPENDIX**

The following items of evidence have been entered into the record, as discussed below.

**A. U.S. Patent No. 3,737,105 To Arnold et al.**

This reference was first used by the Examiner as part of a ground for rejection in the Office Action mailed March 12, 2002.

**B. U.S. Patent No. Des. 425,603 To Guo**

This reference was first used by the Examiner as part of a ground for rejection in the Office Action mailed March 15, 2004.

**C. Kimbrew-Walter Roses Brochure Of Jet-All**

This reference was submitted by Applicant upon filing the present application, and was used as a ground for rejection in the Office Action mailed June 19, 2001.

**D. Declaration of Patrick O'Donnell Under 37 C.F.R. § 1.132 Dated November 8, 2003**

This reference was submitted by Applicant in connection with a Response filed November 26, 2003, and was referred to by the Examiner in the Office Action mailed March 15, 2004.

**1. Exhibit A To 2003 Declaration Of Patrick O'Donnell**

This reference was submitted by Applicant in connection with a Response filed November 26, 2003, and was referred to by the Examiner in the Office Action mailed March 15, 2004.

**2. Exhibit B To 2003 Declaration Of Patrick O'Donnell**

This reference was submitted by Applicant in connection with a Response filed November 26, 2003, and was referred to by the Examiner in the Office Action mailed March 15, 2004.

**3. Exhibit C To 2003 Declaration Of Patrick O'Donnell**

This reference was submitted by Applicant in connection with a Response filed November 26, 2003, and was referred to by the Examiner in the Office Action mailed March 15, 2004.